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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES F. DESMOND

Appeal 2009-000529
Application 10/718,361
Technology Center 3700

Decided: January 27, 2010

Before JENNIFER D. BAHR, MICHAEL W. O'NEILL, and STEFAN
STAICOVICI, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

James F. Desmond (Appellant) filed a Request for Rehearing (hereinafter "Request") under 37 C.F.R. 41.52 of the Decision dated September 18, 2009 (hereinafter "Decision"). In the Decision, the Panel reversed the rejection of claims 25-28, 47, 53, 55, and 57 under 35 U.S.C. § 102(b) as being anticipated by Borden (US 5,918,650) and the rejection of

claims 16-24, 30-32, 54, and 61 under 35 U.S.C. § 103(a) as being unpatentable over Borden. The Panel affirmed the rejection of claims 16-28, 30-32, 47, 53-55, 57, and 61 under 35 U.S.C. § 103(a) as being unpatentable over Borden and Krstovic (US 5,285,824). Appellant's Request is directed only to the portion of the Decision affirming the rejection of claims 16-28, 30-32, 47, 53-55, 57, and 61 as unpatentable given Borden and Krstovic.

Appellant alleges that, in affirming the rejection of obviousness given Borden and Krstovic, the Panel employed an overly broad claim construction of a "flexible squeeze tube." In particular, Appellant alleges the Panel has construed the claim term to mean "that of a 'flexible bag,'" Request 1-2.

The Decision does not construe the claim term of a "flexible squeeze tube" as that of a "flexible bag" as Appellant characterizes. The Decision states "the broadest reasonable interpretation in light of the Specification for the claimed subject matter at issue is a *flexible tube structure that is capable of being squeezed*." Decision 9 (Emphasis added). Appellant's argument that in reading a "flexible squeeze tube" on the flexible bag described within Krstovic, the Panel construed "flexible squeeze tube" as merely requiring any flexible bag overlooks the fact that while Krstovic labels the alternative construction of the container as a "flexible bag," this construction still has to conform to the drip pan opening and have a threaded neck, i.e., a circular cross-section proximate the opening and flaring outward into a container for holding a substantial amount of the oil from the drip pan A. Hence, Krstovic's disclosure does satisfy the broadest reasonable interpretation of a "flexible squeeze tube." As such, Appellant's allegation in the Request that there was any misapprehension in construing the claim term "flexible

squeeze tube” in arriving at the decision to affirm the rejection of claims 16-28, 30-32, 47, 53-55, 57, and 61 as unpatentable given Borden and Krstovic is unconvincing.

Appellant’s allegation that “embodiments have been commercially significant in the area of airport screening” (Request 2) is an argument not previously raised in the Appeal Brief and as such is not permitted in the request for rehearing. *See* 37 C.F.R. § 41.52(a)(1). Moreover, the allegation is insufficient to establish commercial success because the allegation is not supported by evidence. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (attorney’s arguments cannot take the place of evidence). Further, even assuming Appellant had sufficiently demonstrated commercial success, that success is relevant in the obviousness context only if it is established that the sales were a direct result of the unique characteristics of the claimed invention, as opposed to other economic and commercial factors unrelated to the quality of the claimed subject matter. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). Appellant presents no evidence showing a nexus between any commercial success of the embodiments complaint with the “3-1-1 rules of the Transportation Security Administration” and the claimed subject matter.

DECISION

Appellant’s Request has been granted to the extent that we have reconsidered our Decision in light of the arguments in Appellant’s Request, but is denied with respect to our making any modification to the Decision.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REHEARING DENIED

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